D8 Cont'd

CH_3

where R' is: a trisubstituted alkyl; a trisubstituted aryl; an amido group of the formula -(CHR_1)-CO-N< wherein R_1 is hydrogen or an amino group; an imino group of the formula -(CHR_2)-NH-CH< wherein R_2 is hydrogen or an amino group or an imino group of the formula -CH_2-N<; or a phosphate diester; m is 10-50; n is 1-50; and m and n are selected independently.--

REMARKS

Applicant wishes to thank Examiner Schwadron, Examiner Chan and Examiner Swartz for the telephonic interviews held on February 17, 2000 and February 22, 2000. During these telephonic interviews, a number of issues were clarified and a number of amendments were proposed which have helped Applicant to more fully address the concerns of the Examiner. Applicant thanks the Examiners for their time.

Claims 1-22 are pending in the above-referenced patent application; claims 1-22 are currently under examination. Claims 14-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4-12, 24, 29-33 of copending Application Serial No. 08/483,944. Claims 1-22 are pending in the above-referenced patent application; claims 1-22 are currently under examination. Claims 1-22 are rejected under 35 U.S.C. § 103(e) as allegedly being obvious over Kabanov *et al.* (pages 33-36) or Kabanov *et al.* (pages 63-67) in view of Bischofberger *et al.* and Rodwell *et al.*

OBVIOUSNESS-TYPE DOUBLE-PATENTING REJECTION:

Claims 14-22 are provisionally rejected under the judicially created doctrine of obviousness-type double-patenting as being unpatentable over claims 1, 2, 4-12, 24, 29-33 of copending U.S. Patent Application Serial No. 08/483,944. The Examiner has indicated that this provisional rejection can be overcome by timely filing a Terminal Disclaimer.

Applicant acknowledges that copending U.S. Patent Application Serial No. 08/483,944 has claims that are similar to those in the present case. However, Applicant is entitled to at least one patent relating to the claimed invention and, thus, upon withdrawal of

the other outstanding rejections/objections in the present case, Applicant will cancel the conflicting claims in copending U.S. Patent Application Serial No. 08/483,944 or, alternatively, he will file a Terminal Disclaimer. As such, Applicant respectfully requests that this provisional rejection be held in abeyance until the other outstanding objections/rejections have been withdrawn.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1-22 remain rejected under 35 U.S.C § 103(a) as allegedly being obvious over Kabanov *et al.* or Kabanov *et al.* (pages 63-67) in view of Bischofberger *et al.*, Rodwell *et al.* As amended, all of the pending claims are directed to a lipidized protein (*e.g.*, a lipidized antibody) that is (1) a protein (*e.g.*, an antibody) covalently linked to a lipid having a hydrocarbon tail of at least 12 carbons through a carbohydrate moiety; and (2) a lipidized protein (*e.g.*, a lipidized antibody) that is capable of transvascular transport, enhanced organ uptake and intracellular localization. For the reasons set forth herein, the presently claimed lipidized proteins are not obvious over the prior art.

During the telephonic interviews, it was agreed that the lipidized antibodies of Kabanov *et al.* are structurally different from the claimed lipidized proteins because they are not "lipidized protein (or antibody), wherein said lipidized protein (or antibody) is a protein (or antibody) covalently linked to a lipid having a hydrocarbon tail of at least 12 carbons through a carbohydrate moiety" as is required by all the pending claims. During the telephonic interviews, it was also agreed that Rodwell *et al.* do not teach attaching aminolipids to antibodies and that Bischofberger *et al.* do not teach attaching an aminolipid to an antibody.

Furthermore, during the telephonic interviews, it was agreed that the teachings of Kabanov *et al.* cannot be looked at in combination with Rodwell *et al.* or Bischofberger *et al.* alone, but rather must be looked at in combination with the teachings of Horan *et al.*, since Horan *et al.* was clearly part of the art at the time of the invention. As discussed during the telephonic interviews, Horan *et al.* in combination with the other cited art teaches away from the claimed invention. As amended, the present invention achieves surprising results neither

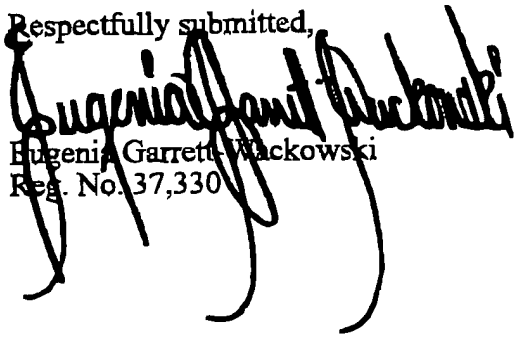
disclosed nor suggested in the art at the time of the invention. In view of the foregoing, the present invention as amended is clearly non-obvious and, thus, patentable.

During the telephonic interview, a number of amendments were discussed that would more clearly distinguish the claimed invention from the art cited by Examiner Schwadron and that would put the present invention in condition for allowance. In order to expedite prosecution, Applicant has amended the claims to comply with the Examiners' request. Accordingly, Applicant urges the Examiner to withdraw this rejection under 35 U.S.C. § 103(a).

CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance and an action to that end is urged. If the Examiner believes a telephone conference would aid in the prosecution of this case in any way, please call the undersigned at 415-576-0200.

Respectfully submitted,



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